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Michael C. Houck, Paralegal

December 15, 2006
(Date Signed)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No. : 10/762,625
Applicant : Adrian Bachtold
Filed : January 22, 2004
Title : ELECTRONIC DEVICE USING CARBON NANOTUBES

TC/A.U. : 2811
Examiner : Douglas W. Owens

Docket No. : 30394-1112

Mail Stop: AF

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

RESPONSE UNDER 37 C.F.R. 1.116

EXPEDITED PROCEDURE – EXAMINING GROUP 2811

Dear Sir:

In response to the Examiner's Advisory Action dated November 30, 2006 and request for additional information regarding applicant's entry application into the U.S. claiming benefit of application of PCT/NL01/00577 filed July 21, 2001, an international application designating the U.S.

PCT/NL01/00577 filed July 21, 2001 (WO 03/01837) enclosed.

A copy of the PCT/NL01/00577 filed July 21, 2001 as published (WO 03/01837) is attached as requested by the Examiner. The WO 03/01837 publication of the PCT/NL01/00577 application reflects that the "US" is a designated state for the application and a WIPO notice that the application was filed designating the US is transmitted by the international bureau to designated state patent offices.

PCT/NL01/00577 application claimed for U.S. domestic priority.

The U.S. application was filed January 22, 2004 and received by the U.S. Patent Office generating an official filing receipt on April 27, 2004. The official filing receipt of the U.S. Patent and Trademark Office identified the PCT/NL01/00577 application as the domestic priority document and an international application designating the U.S., and the international filing date July 26, 2001, which is considered as the filing date in the U.S. under PCT Article 11(3). PCT/NL01/00577 application was claimed for U.S. domestic priority in the Application Data Sheet filed concurrently with the U.S. application January 22, 2004. As such, applicant believes it has complied with 35 USC 111, 35 USC 365, and MPEP 1.78(a)(1) and (2) for providing the required reference and notice claiming benefit of the filing date of the prior application, an international application designating the U.S., within the pendency of the PCT/NL01/00577 application.

A Notice of Missing Parts was generated April 27, 2004 for applicant to complete the initial filing with any missing documents. The only document requested by the document in-take and processing office at the U.S. Patent and Trademark Office was for a signed declaration by the inventors. The PCT/NL01/00577 application claimed by applicant as a domestic priority document was not requested to complete the filing in the U.S. Patent and Trademark Office as the required reference claiming U.S. domestic priority in the Application Data Sheet was filed concurrently with the U.S. application on January 22, 2004.

PCT/NL01/00577 published as WO 03/01837 and Line-Out document requested by

Examiner.

The patent application document filed by applicant on January 22, 2004 contains the specification and drawings of PCT/NL01/00577 as published in WO 03/01837. The filed document for U.S. entry contains the names of the individual inventors rather than the assignee as indicated in the international application as the applicants, amended claims and abstract that conform the international application to

U.S. practice, and, while not introducing new matter, introduces changes to the claims that are different from the priority, published international application.

Specification: In the copy of the Line-Out document submitted herein, this document is prepared using current software that paginates the specification differently from the submitted hard copy of the original application. However, no changes were made to the specification in filing PCT/NL01/00577 (WO 03/01837) as the U.S. national application.

Claims: In the copy of the Line-Out document submitted herein, applicant provides a side-by-side comparison of the claims in PCT/NL01/00577 (WO 03/01837) and the amended claims in the original U.S. national application.

Abstract: In the copy of the Line-Out document submitted herein, applicant provides a side-by-side comparison of the Abstract from PCT/NL01/00577 (WO 03/01837) and the amended Abstract in the original U.S. national application.

REMARKS

The Examiner's continued attention to the present application is noted with appreciation.

In paragraphs 1 and 2 of the Office Action dated September 25, 2006, the Examiner rejected claims 1 through 5 under 35 U.S.C. § 102(e) as being anticipated by Dai et al. (U.S. Published Patent Application No. 2004/0144972). Applicant respectfully disagrees. The instant application claims priority to a PCT application (PCT/NL01/00577) with an international filing date of July 26, 2001. Dai et al. claims priority to a provisional application (60/416,326) filed October 4, 2002. Therefore, Dai et al. is not available as prior art under U.S.C. § 102(e).

In view of the above remarks, it is respectfully submitted that all grounds of rejection and objection have been avoided and/or traversed. It is believed that the case is now in condition for allowance and same is respectfully requested.

If any issues remain, or if the Examiner believes that prosecution of this application might be expedited by discussion of the issues, the Examiner is cordially invited to telephone the undersigned attorney for Applicant at the telephone number listed below.

Authorization is given to charge payment of any additional fees required, or credit any overpayment, to Deposit Acct. 13-4213.

Respectfully submitted,

By: 

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